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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Application Number: 09/282,320

Filing Date: March 31, 1999

Appellant(s): MARTINO ET AL.

Russell Gross
(Reg. No. 40,007)
and
Steve Cha
(Reg. No. 44,069)
For Appellant

SUPPLEMENTAL
EXAMINER'S ANSWER

This is in response to the reply brief filed 1/26/2005.

(1) *Response to Argument*

Appellant's remarks on Reply Brief have been considered and are deemed not persuasive for the following reasons.

In response to appellant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

In response to applicant's argument that fitting the Baumgarten reflective surface around the Kamaya lens would interfere with user's hand, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981). In this case, Baumgarten clearly discloses an image generating device (4, figure 5) for quickly and easily inspecting users' own appearance including a framing mirror (24, figure 5) having a reflection surface, that is substantially greater than the lens surface, in front of a camera (70, figure 5) so that the mirror is movably arranged at an angle to the camera (col. 3 lines 29-51), wherein the mirror comprises a two-way transparent center area, i.e., a hole (80, figure 5), located at the center area of the mirror (40, figure 5), to permit the camera to capture image, thereby increasing the clarity of the video signal (col. 6 lines 1-14). Thus, one ordinary skill in the art at the time the invention was made would have been motivated to make a

modification of Kamaya as taught by Baumgarten in order to let users to quickly and easily inspect their own appearance during camera operation, as well as increasing the clarity of the video signal captured by the camera (see Baumgarten, col. 2 lines 2-7 and col. 6 lines 1-6).

Appellants' remark on the Kamaya user being close to the lens and Janow user being located far from the camera lens is misleading because the issue of applying Janow is to provide a transparent material inserting in front of a camera to form a two-way transparent solid center area for making the existing hole less apparent to a viewer (see Janow col. 5 lines 43-45). Appellant ignored examiner's rationale of combining Kamaya, Baumgarten and Janow. Instead, Appellant attacked references individually where the rejections are based on combinations of references. In addition, Appellant's reply page 6 line 20 contains an error that "Kamaya lens 507" should be --Janow lens 507-- to be corrected.

Appellant's assertion on Examiner's Answer seem to suggest substituting the Janow transparent material 701 for the Kamaya half mirror 10 to allow the Kamaya camera 1a to retain more incoming light is misleading and incorrect because the Examiner's Answer, as well as the Final action, clearly pointed out that the use of Janow is for teaching a transparent material (701, figure 7) inserted into a hole (401, figure 7) or to remove in the area of hole (401, figure 1) the reflective coating in order to make the camera image appears more uniform and the existence of the hole is less apparent to a viewer (figures 5-7 and col. 5 lines 43-45). Thus, the Examiner's Answer has never suggested the assertion as stated in the Reply Brief pages 6-7.

Appellants' remark on what would have motivated re-designing Kamaya to operate with an unwieldy Baumgarten reflecting surface that interferes with the user operating the start/stop switch 9 that is disposed for ease of use closely adjacent to the lens 5 is misleading because the

question of obviousness is based on underlying factual determinations including what the prior art teaches explicitly and inherently. In this case, the use of Baumgarten is for teaching image generating device (4, figure 5) including a framing mirror (24, figure 5) having a reflection surface, that is substantially greater than the lens surface, in front of a camera (70, figure 5) so that the mirror is movably arranged at an angle to the camera (col. 3 lines 29-51) for quickly and easily inspecting users' own appearance, wherein the mirror comprises a two-way transparent center area, i.e., a hole (80, figure 5), located at the center area of the mirror (40, figure 5), to permit the camera to capture image, thereby increasing the clarity of the video signal (col. 6 lines 1-14). Thus, one skill in the art would have motivated to modify Kamaya in having the mirror moveably arranged at the angle to the camera and having the two-way transparent center area to permit the camera to capture image. In addition, combining the teaching of Kamaya and Baumgarten does not require re-designing Kamaya to operate with an unwieldy Baumgarten reflecting surface. The argument overlooks "the relevant combined teachings of the references..." *Anderson*, 391 F.2d at 958, 157 USPQ at 281. More specifically, it is not necessary that the invention of the references be physically combinable to render obvious the invention. The test for obviousness is not whether the features of a reference may be bodily incorporated into the structure of another reference but what the combined teachings of the references would have suggested to those of ordinary skill in the art.

Appellants' remark on Janow being not directed to a mirror is misleading since the issue is directed to provide a transparent material inserting in front of a camera to form a two-way transparent solid center area for permitting the camera to capture the camera image. Once again, Appellant attacks references individually where the rejections are based on combinations of

references. In this case, the combination of Kamaya and Baumgarten clearly teaches a mirror as claimed, which the mirror includes a two-way transparent center area, i.e., a hole 80, to permit camera to capture the camera image (see Baumgarten figure 5 and col. 6 lines 1-14), wherein the mirror also include a cover (50, figure 2) having a mirror coating so that the user can slide the cover over the hole to view the image of user (col. 6 lines 10-12). The combination of Kamaya and Baumgarten differs from the claimed invention in not specifically teaching a two-way transparent material inserted in front of the camera in order to form a two-way transparent solid center area. Although Janow transparent material 701 fills in a hole in a Janow projection screen rather than a mirror, Janow clearly teaches the advantage of inserting transparent material (701, figure 7) in a hole (401, figure 7) in front of a camera (501, figure 7) in order to make the transparent center area more uniform when displaying an image and the existence of the hole being less apparent to a viewer (col. 5 lines 42-55). Thus, a person of ordinary skill in the art would obviously have been motivated to modify the combination of Kamaya and Baumgarten to produce the claimed invention in view of Janow's advantageous teaching as discussed above.

Appellants' remark on applying Baumgarten pivotal mounting to the Kamaya hand-held camera is misleading because the test for obviousness is not whether the features of a reference may be bodily incorporated into the structure of another reference but what the combined teachings of the references would have suggested to those of ordinary skill in the art. Note Baumgarten teaches image generating device (4, figure 5) including a framing mirror (24, figure 5) having a reflection surface, that is substantially greater than the lens surface, in front of a camera (70, figure 5) so that the mirror is movably arranged at an angle to the camera (col. 3 lines 29-51) for quickly and easily inspecting users' own appearance, wherein the mirror

comprises a two-way transparent center area, i.e., a hole (80, figure 5), located at the center area of the mirror (40, figure 5), to permit the camera to capture image, thereby increasing the clarity of the video signal (col. 6 lines 1-14). Thus, one skill in the art would have motivated to modify Kamaya, as per teaching of Baumgarten, to achieve the claimed invention because it make user friendly so that users can quickly and easily inspect their own appearance during an operation, as well as increasing the clarity of the video signal captured by the camera.

For at least all of the above reason, the proposed combination renders obvious the present invention as recited in claim 1. Note independent claims 11, 15 and 18 have been previously amended in a similar fashion as claim 1, therefore the Examiner respectfully submits that these claims are also obvious over the combination of Kamaya, Baumgarten and Janow.

Furthermore, claims 2, 4-7, 9-10, 12-14 and 19-20 are believed to be obvious for the various reasons as set forth in the final Office rejections.

With regard to the rejection of claims 3, 8 and 16-17, the combination of Kamaya, Baumgarten and Janow discloses or suggest Applicants' base claims 1 and 15, and therefore claims 3, 8 and 16-17 are also obvious over the combination of Kamaya, Baumgarten and Janow in view of Braun, Kawashima and Parulski, respectively, as set forth in the final Office rejections.

(2) Conclusion

For the above reasons, the Examiner respectfully submits that a **prima facie** case of obviousness of the claimed invention has been set forth in the Final Office action and appellants have failed

to overcome the prima facie case of obviousness. Accordingly, it is believed that the final rejection under 35 U.S.C. § 103 is proper and the Board of Patent Appeals and Interferences is therefore respectfully urged to sustain the Examiner's rejection.

Respectfully submitted,


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